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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. WITZ,
BRIAN A. LEVY,
BRIAN N. SAWYER,
DAN LIN,
and GORDON K. GUSTAFSON

Appeal 2012-004361
Application 09/599,051
Technology Center 3600

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Michael J. Witz, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1, 3-8, and 22-29. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.¹

THE INVENTION

The invention relates to “financial products derived from the input of a virtual community.” Specification 1:5.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A machine-implemented method comprising:

receiving, from a device of a first user over a wide-area network, an indication of a preference of a weighted apportionment of assets for a set of investments, the first user being a member of a first population of users, which are members of a virtual community identified as investment analysts;

aggregating the preference into a database of previously received preferences from the first population, the aggregation being an updated set of preferences;

adjusting the updated set of preferences according to a population-weighted-scale; and

¹ Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Oct. 7, 2011) and the Examiner’s Answer (“Answer,” mailed Oct. 28, 2011).

deriving, according to the adjusted set of preferences, an investment position in a financial product for a second user, the second user is a member of a second population of users identified as investors, and the financial product is a mutual fund.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Amram	5,537,586	Jul. 16, 1996
Segal	6,049,783	Apr. 11, 2000
Reese	6,236,980 B1	May 22, 2001
Wallman '047	6,338,047 B1	Jan. 8, 2002
Agarwal	6,408,309 B1	Jun. 18, 2002
Phillips	6,473,084 B1	Oct. 29, 2002
Wallman '539	6,996,539 B1	Feb. 7, 2006

The following rejections are before us for review:

1. Claims 1, 3, 8, and 22-29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Reese, Agarwal, Amram, and Wallman '539.
2. Claims 4 and 5 are rejected under 35 U.S.C. §103(a) as being unpatentable over Reese, Agarwal, Amram, Wallman '539, and Segal.
3. Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Reese, Agarwal, Amram, Wallman '539, and Phillips.
4. Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over Reese, Agarwal, Amram, Wallman '539, and Wallman '047.

ISSUE

Has the Examiner presented a prima facie case of obviousness for the claimed subject matter over the cited prior art combination?

FINDINGS OF FACT

The Examiner's factual findings are stated in the Answer (Ans. 4-10).

ANALYSIS

The rejections of claims 1, 3, 8, and 22-29 under 35 U.S.C. § 103(a) as being unpatentable over Reese, Agarwal, Amram, and Wallman '539; claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Reese, Agarwal, Amram, Wallman '539, and Segal; claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Reese, Agarwal, Amram, Wallman '539, and Phillips; and claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Reese, Agarwal, Amram, Wallman '539, and Wallman '047.

Both independent claims, method claims 1 and 22, call for “aggregating [a] preference [of a weighted apportionment of assets for a set of investments] into a database of previously received preferences from [a] first population [of users, which are members of a virtual community identified as investment analysts], the aggregation being an updated set of preferences; [and,] adjusting the updated set of preferences according to a population-weighted-scale.”

The Examiner found that “Amram teaches the concept of having preferences as a weighted apportionment of assets and adjusting the updated set of preferences according to a population-weighted-scale (“normalization”) (col. 6, lines 60 through col. 7, lines 10).” Ans. 6. Col. 6, l. 60 – col. 7, l. 10 of Amram is reproduced below:

Referring now to FIG. 5, the step of supplying profile information (FIG. 1, step 106) includes providing the system with a user selection of category records (step 132). The selected category records may be weighted to indicate not only priority among categories, but also degrees of preference. Alternatively, the user may select default weights (step 134). If default weights are selected, the system assigns

successive decreasing integer values for the weights based on his or her preferences (step 136). Alternatively, the user may enter weights for the various categories (step 138). The final weight determination is then made (step 140), which is essentially a normalization of the weights relative to the other weights, and may be performed using the following formula.

$$W_i = \frac{w_i}{\sum_{j=1}^n w_j}$$

“Analysis begins with a key legal question -- *what is the invention claimed?* Courts are required to view the claimed invention *as a whole*. 35 U.S.C. § 103. Claim interpretation, in light of the Specification, claim language, other claims, and prosecution history, is a matter of law and will normally control the remainder of the decisional process.” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567-68 (Fed. Cir. 1987). “Claim construction begins, as it must, with the words of the claims. *See Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 619-20 (Fed. Cir. 1995).” *Vehicular Techs. Corp. v. Titan Wheel Int'l*, 141 F.3d 1084, 1088 (Fed. Cir. 1998). “[C]laims are to be read in the light [of the specification], not in a vacuum.” *In re Dean*, 291 F.2d 947, 951 (CCPA 1961).

The claims call for “adjusting [an] updated set of preferences according to a population-weighted-scale.” Setting aside that we have been unable to find in Amram, or any other cited reference, disclosure of *updating* preferences or adjusting *updated* preferences, the question is whether Amram discloses adjusting values, such as updated preferences, “according to a population-weighted-scale” as the claimed methods require and as the Examiner has asserted that it does.

The Specification discloses:

In one embodiment, the weighting takes the form of compiling a list of unique ticker symbols submitted as preferences. Each unique ticker symbol is then equal dollar weighted. The resulting number of shares is multiplied by the frequency the preference was submitted by members of the community. The resulting value is termed a population weighted scale (PWS). The above described PWS provides an indication of the overall all community opinion.

Specification 6:17-22. Accordingly, giving the claims the broadest reasonable construction as interpreted by one of ordinary skill in the art in light of the Specification, one of ordinary skill in the art would reasonably broadly interpret the claim limitation at issue as “adjusting [an] updated set of preferences according to [a resulting number of shares [] multiplied by the frequency the preference was submitted by members of a virtual community identified as investment analysts].”

Turning to Amram, it discloses a user selection of category records which may be weighted to indicate degrees of preference. This is not a disclosure of “adjusting [an] updated set of preferences according to [a resulting number of shares [] multiplied by the frequency the preference was submitted by members of a virtual community identified as investment analysts]” as the claim at issue would be reasonably broadly in light of the Specification. Accordingly, the evidence does not support the Examiner’s finding that “Amram teaches the concept of having preferences as a weighted apportionment of assets and adjusting the updated set of preferences according to a population-weighted-scale” Ans. 6.

We note the Examiner’s equating of population-weight-scale and normalization. See “population-weighted-scale ("normalization")”, Ans. 6. While it is true that the term “normalization” appears both in Amram and the Specification in their respective discussions of preference-weighting, in both disclosures, normalization is a subsequent step performed after the

preferences have been weighted. The methods of claims 1 and 22 are not limited to require further normalization. It unduly narrows the claimed subject matter to read the claimed method as performing a normalization. The claimed method simply weigh preferences, albeit “[an] updated set of preferences according to [a resulting number of shares [] multiplied by the frequency the preference was submitted by members of a virtual community identified as investment analysts].”

Because Amram does not disclose “aggregating [a] preference [of a weighted apportionment of assets for a set of investments] into a database of previously received preferences from [a] first population [of users, which are members of a virtual community identified as investment analysts], the aggregation being an updated set of preferences; [and,] adjusting the updated set of preferences according to a population-weighted-scale” as the claims require, given the broadest reasonable construction as interpreted by one of ordinary skill in the art in light of the Specification, and as the Examiner has asserted, the rejections are reversed as not presenting a prima facie case of obviousness in the first instance.

DECISION

The decision of the Examiner to reject claims 1, 3-8, and 22-29 is reversed.

REVERSED

JRG